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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,619	09/29/2000	Robin T. Castell	1662-27100 (P00-2945)	9571

7590 06/23/2003

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EXAMINER
LEA EDMONDS, LISA S

ART UNIT	PAPER NUMBER
2835	

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/675,619	Applicant(s) CASTELL ET AL.	
	Examiner Lisa Lea-Edmonds	Art Unit 2835	

-- The MAILING DATE of this communication appears on th cover sh et with th correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 April 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7,12,16,17,20-22,25 and 26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *12,17,22,25 and 26* is/are allowed.

6)☒ Claim(s) *7, 16, 20, 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 7, 16, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inkinen in view of Taylor et al., and further in view of Chadima, Jr.. With respect to claims 7, 16, 20, and 21, Inkinen teaches a wireless network adapter (200) comprising wireless communication circuitry encased in a shell comprising a modulator (424) configured to produce a transmit signal suitable for conveying data on a wireless link, and a demodulator (425) configured to produce a base band signal that conveys information received via a wireless link, wherein the shell is a detachable molding element of an electronic device; and a bus connector (101) adapted to couple the wireless communication circuitry to an expansion bus when the shell is attached to an outer surface of an electronic device having and expansion bus as claimed (see for example column 4 line 13 through column 11 line 23). However, Inkinen lacks a clear teaching of the use of a radio modem as claimed. The apparatus of Taylor et al. is relied upon for it's teaching of a radio modem that can be built into the host unit or attached to a host unit through a PCMCIA or similar port. The radio modem of Taylor comprises a bus interface, a base band controller, and a radio transceiver that combine to modulate data onto a radio frequency carrier signal as claimed (see for example column 6 line 20 through column 12 line 47). Inkinen also lacks a clear teaching of the antenna being shaped into a company logo as claimed. The apparatus of Chadima, Jr. is relied upon for it's teaching of an antenna being

shaped into an ornamental arrangement such as a company logo (see for example the abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Taylor et al. into the teachings of Inkinen to clearly teach the use of a radio modem as claimed. Also, it would have been obvious to one skilled in the art to incorporate the radio modem of Taylor into the radio module of Inkinen as it is well known in the art that a "modem" is a means of modulation and demodulation which allow a computer to transmit and/or receive information over a telephone line or by wireless means such as inferred (IR) or an antenna. It also would have been obvious to one of ordinary skill in the art to shape the antenna into any ornamental arrangement so as to conceal the antenna given the teachings of Chadima, Jr..

3. Claim 9 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Inkinen in view of Taylor et al., and further in view of Hsu et al... With respect to claim 9, Inkinen teaches a wireless network adapter (200) comprising wireless communication circuitry encased in a shell comprising a modulator (424) configured to produce a transmit signal suitable for conveying data on a wireless link, and a demodulator (425) configured to produce a base band signal that conveys information received via a wireless link, wherein the shell is a detachable molding element of an electronic device; and a bus connector (101) adapted to couple the wireless communication circuitry to an expansion bus when the shell is attached to an outer surface of an electronic device having and expansion bus as claimed (see for example column 4 line 13 through column 11 line 23). However, Inkinen lacks a clear teaching of the use of a radio modem as claimed. The apparatus of Taylor et al. is relied upon for it's teaching of a radio modem that can be built into the host unit or attached to a host unit through a PCMCIA or similar port. The radio modem of Taylor comprises a bus interface, a base band controller, and a radio transceiver that combine to modulate data onto a radio frequency carrier signal as

claimed (see for example column 6 line 20 through column 12 line 47). Inkinen also lacks a clear teaching of the radio modem incorporating diversity antenna technology as claimed. The apparatus of Hsu et al. is relied upon for it's teaching of a radio modem incorporating diversity antenna technology as claimed (see for example the abstract and column 2 lines 33-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Taylor et al. into the teachings of Inkinen to clearly teach the use of a radio modem as claimed. Also, it would have been obvious to one skilled in the art to incorporate the radio modem of Taylor into the radio module of Inkinen as it is well known in the art that a "modem" is a means of modulation and demodulation which allow a computer to transmit and/or receive information over a telephone line or by wireless means such as inferred (IR) or an antenna. It also would have been obvious to one of ordinary skill in the art to incorporate the teachings of Hsu et al. into the apparatus of Inkinen in view of Taylor to provide the user with means to link with numerous frequencies without the use of multiple antennas, thus compacting the modem and antenna.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, II as applied to claim 13 above, and further in view of Steinberg et al.. With respect to claim 15, Smith, II teaches a computer system (10, 90), comprising a system microprocessor; an expansion bus couples to the microprocessor and configured to transport data to and from at least one input/output device; an input/output device operatively coupled to the microprocessor; and an expansion port connected to the expansion bus, wherein the expansion port is configured to accept a detachable molding element (11, 21, 32, 80) housing an expansion device (13, 14, 17, 23, 24, 27, 36, 37, 46, 32). However, Smith, II lacks a clear teaching of the expansion device being a biometric security device as claimed. The apparatus of Steinberg et al. is relied upon for it's teaching of camera with biometric security (see for example the

abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Steinberg et al. into the apparatus of Smith, II to provide the user with security means.

Response to Arguments

5. Applicant's arguments, see page 8 line 11 through page 9 line 17, filed 04/23/03, with respect to the antenna of Chadima, Jr. that forms part of a company logo have been fully considered and are persuasive. The rejections of claims 9 and 13-15 have been withdrawn.

6. In response to applicant's argument that the antenna of Chadima, Jr. that forms part of a company logo, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

7. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

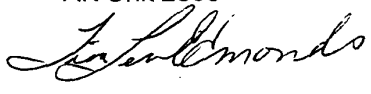
Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Lea-Edmonds whose telephone number is 703-305-0265. The examiner can normally be reached on 6:30 am to 3:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 703-308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3432 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1782.

Lisa Lea-Edmonds
Examiner
Art Unit 2835



June 19, 2003